

REMARKS / ARGUMENTS

In response to the Office Action mailed April 21, 2008, the Examiner's claim rejections have been considered. Applicants respectfully traverse all the rejections regarding each pending claim and earnestly solicit allowance of these claims.

1. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 and 7-20 under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff (U.S. Patent No. 6,398,645) in view of Marnell, II, (U.S. Patent No. 5,393,057).

Neither Yoseloff nor Marnell II discloses presenting the winning event from the bingo game as a game outcome of non-bingo game of chance, as recited in Applicants' claims 1, 8 and 14. (The wording of claim 14 is not identical to claims 1 and 8. Claim 14 reads, "results from the bingo game are displayed as non-bingo game of chance"). According to the claimed invention, player perceives to be playing a non-bingo game (e.g., slots or poker), but the player is actually playing a bingo game. For example, the player initiates the slots game and the reels begin to spin. Concurrently, a bingo game is run where a ball draw occurs, the player's card is automatically daubed, and the gaming machine determines whether the player has achieved a "bingo." The reels of the slots game stop to present the slots-game outcome, which corresponds to the outcome of the bingo game. If the player achieves a bingo, a winning slots-pattern is presented on the payline of the slots game. If the player did not achieve a bingo, a non-winning slots pattern is presented on the payline. In contrast, Marnell II discloses a card game or a slot game as a primary game. When a winning event occurs in the primary game, such as a certain hand or a certain combination of elements on the slot, a space is blotted in the bingo game, which is the secondary game.

Nor would it have been obvious to one of ordinary skill in the art to modify Marnell II to render obvious Applicants' claims 1, 8 and 14. Applicants claimed invention (as recited in claims 1, 8 and 14) allows casinos operating under IGRA to run a game that looks like a non-bingo game without entering into a State compact. See Specification, p.3, lines 13-17. Neither Marnell II nor Yoseloff discloses such a benefit.

Marnell II fails to disclose presenting the winning event from a primary game as a game outcome of the non-primary game of chance. As stated above, in Marnell II, when a winning event occurs in the primary game, a space is blotted in the bingo game. But blotting a space in a bingo game is not a “game outcome,” as recited in Applicants’ claims 1 and 8, or “results” of a bingo game, as recited in Applicants’ claim 14. Thus, winning a poker hand in Marnell II is not presented as a winning bingo card, rather as one space on a bingo card. Nothing in either Yoseloff or Marnell II provides any motivation to one of ordinary skill in the art to present a winning event from a bingo game as a game outcome of a non-bingo game of chance.

The Examiner states that Marnell II discloses a player being automatically awarded an outcome of the secondary game corresponding to the outcome of a primary game. Applicants respectfully disagree. The cited portion of Marnell II (col. 2, lines 48-53) discloses that the spaces on the bingo card may be automatically filled, or the player may fill them, with characters representing events in the primary game. For example, when the player gets a full house, the space corresponding to a full house on the bingo card would be filled. See Marnell II, col. 2, lines 57-62. However, neither Marnell II nor Yoseloff discloses that winning a primary game, such as poker, would be presented as winning a secondary game, such as bingo.

The Examiner further admits that Marnell II fails to disclose using bingo as a primary game. The Examiner states that it would have been a matter of choice, well within the capabilities of one skilled in the art, to use a bingo game as the primary game and another game as a secondary game. Applicants respectfully suggest that this is an inappropriate basis for determining obviousness under 35 U.S.C. § 103(a). Neither Marnell II nor Yoseloff discloses using bingo as a primary game and presenting the winning event from the bingo game as a game outcome of non-bingo game of chance. Further, neither Marnell II nor Yoseloff contains any motivation to change Marnell II to use bingo as a primary game and present the winning event from the bingo game as a game outcome of non-bingo game of chance. See MPEP 2144.04(IV)(B) (“The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)).

The Examiner cites Marnell II, col. 5, lines 8-14 as a motivation for linking a primary game to a secondary game, generally. (“...to provide a new dimension of game strategy and greatly enhanced entertainment value of a progressive jackpot, [a] game apparatus... includes a secondary... gaming device... which is linked electrically to the primary... gaming device”)

Applicants suggest that the games recited in Applicants’ claims 1, 8 and 14 provide no such advantage. In fact, modifying Marnell II or combining Marnell II and Yoseloff according to Applicants’ claims 1, 8 and 14 would render the game unsatisfactory for its intended use. See MPEP § 2143.01(v) “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” If Marnell II is combined with Yoseloff, the resulting game would be a primary bingo game with a bingo card that is the secondary game. This resulting game would be contrary to the Examiner’s cited motivation of providing new game strategy and entertainment value, since the player is playing a primary bingo game and a secondary bingo bonus game.

In Marnell II, a player may win by playing a card game or on a slot machine. But a player may further win by continuing to play, thereby filling up spots on a bingo card. Also, in an electronic card game, for example, a person may choose to pursue a two-of-a-kind instead of a full house if the two-of-a-kind would help the player with the bingo game. Such a connected game provides a new dimension of strategy to the card game, since a full house is usually considered preferable to a two-of-a-kind. The games of Applicants’ claims 1, 8 and 14 provide no such enhanced strategy. Rather, the player plays a bingo game, but the results show up as a non-bingo game, such as a poker result. Such a configuration allows casinos operating under IGRA to run a game that looks like a non-bingo game without entering into a State compact. See Specification, p.3, lines 13-17.

Marnell II further teaches away from such a modification and would not be combined with Yoseloff. Marnell II discloses only card games, slot machines, dice games, and trivia games as primary games connected to a bingo machine. Marnell II states,

“[G]ames which have a plurality of events which occur and can be given different values, such as poker hands in a poker game, combinations of reels in a slot machine game, or die combinations in a dice game, are particularly well suited for use as the primary gaming device.” (Marnell II, col. 3, lines 63-68)

Card games and slot machines are suited to connecting to a bingo machine, because each hand or pull can have a unique result and can correspond to a unique space on a bingo card. Marnell II teaches away from using bingo as a primary game because each bingo number or combination of numbers provides the same result (i.e., a “bingo” that comprises five numbers in a row, column, or diagonal).

Yoseloff and Marnell II further fail to disclose determining, for each virtual bingo card in the gaming session, if a bonus win event occurred and presenting the bonus win event as a game outcome of a non-bingo game of chance, as recited in Applicants’ claims 1 and 8.

Regarding claim 8, Yoseloff and Marnell II further fail to disclose, after presenting a win event as a game outcome of a non-bingo game of chance, sending any remaining bingo balls from the bingo ball draw to the two or more bingo player terminals to generate a bonus game and presenting the bonus game to the two or more bingo player terminals.

Regarding claim 14, Yoseloff and Marnell II further fail to disclose awarding progressive prizes in a bonus game, where a progressive prize is a prorated progressive jackpot amount that is dependent upon the wager of the player. Marnell II discloses providing progressive jackpots to a player based on results of card hands, rather than a wager of a player. Nothing in either Yoseloff or Marnell II would have motivated one of ordinary skill in the art to modify Marnell II to award a prorated progressive jackpot amount that is dependent upon the wager of the player.

Regarding claim 17, Yoseloff and Marnell II fail to disclose generating an ordered ball draw for the gaming session and initiating a bonus game on the two or more bingo game terminals if a predetermined minimum number of bingo balls remain in the ordered ball draw. Nor is there any disclosure in either Yoseloff or Marnell II that would have motivated one of ordinary skill in the art to initiate a bonus game if a predetermined number of bingo balls remain in an ordered ball draw.

Applicants note that claims 2, 3, 7, 9-13, 15, 16, and 18-20 are dependent claims that depend from independent claims 1, 8, 14, and 17, respectively. In light of the arguments submitted in this section, Applicants respectfully submit that dependent claims 2, 3, 7, 9-13, 15, 16, and 18-20 are not obvious in view of the combination of Yoseloff and Marnell II because these references, alone or in combination, fail to teach or suggest all the claimed limitations. Moreover, these dependent claims further recite and define the claimed invention, and thus, are

independently patentable. In conclusion, Applicants respectfully submit that the 35 U.S.C. §103(a) rejection of claims 1-3 and 7-20 have been overcome.

CONCLUSION

Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 1-3 and 7-20 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (202) 429-6259. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Eastern Time.

Respectfully submitted,

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